

REMARKS

Claims pending in the application are 1-29. The claims are subject to a restriction requirement (See paragraph 1 on page 2 of the Examiner's communication of March 12, 2007) between claims 1-23 (composition) and claims 24-29 (process for removing greases using the claimed composition. The restriction requirement has been maintained (See paragraph 2 on page 2 of the Examiner's communication of June 18, 2007).

Description of Amendments to the Claims

Claims 1-29 have been amended to more particularly set forth the claimed invention. More specifically, claim 1 has been amended by deleting the redundant term "free radical" from the next to last line of the claim. This conforms the language of claim 1 to the language found in paragraph [0007] on page 3, lines 9-11 of the specification. Claims 9, 21, 24 and 28 have been similarly amended to conform the language in such claims to that now found in amended claim 1.

Claim 8 has been amended to remove the redundant term "group" from line 2 of that claim; and claims 9-12 and 14 have been amended to remove the redundant term "stable" from line 2 of such claims.

Claims 25 and 28 have been amended by adding the term "surface of the" to those claims. The term "surface" is found in paragraph [0002] at page 1, line 14 of the specification. This amendment further delineates the claimed vapor degreasing process as a process that, as described, degreases the "surface" of the article being cleaned.

Comments Respecting Pending Claims Not Identified in the Communication

Claims 5 and 8-17 are not specified in the formal rejection; however, since these claims depend directly or indirectly from claim 1, they will be considered to have been rejected for the same reasons as stated in the rejection of claim 1.

Claim 23 is not specified in the formal rejection; however, since claim 23 depends directly from claim 22, it will be considered as being rejected for the same reasons as stated in the rejection of claim 22.

Claims 18-20 are not specified in the formal rejection and hence have not been rejected. Further, these claims have not been allowed. It is requested that the status of claims 18-20 be clarified in the Examiner's next communication.

It should be noted additionally that claim 18 is directed to a composition consisting essentially of trans 1,2-dichloroethylene and a stabilizing amount of each of (a) butylene oxide, (b) isopropyl alcohol, and (c) free radical stabilizer material having at least one 2,2,6,6-tetra(lower alkyl)-1-piperidinyloxy-yl free radical group. The combination of stabilizer materials claimed in claim 18 is **not described** in the cited Cook patent. More particularly, the named **free radical stabilizer** material is not disclosed in the Cook patent. Hence, the cited Cook patent does not anticipate or make obvious the composition of claim 18

Claims 24-29 are considered to having been withdrawn from further consideration by the Examiner since the restriction requirement was maintained.

Rejection Under 35 U.S.C. 102(b)

Claims 1-4, 6, 7, 21 and 22 have been rejected under 35 U.S.C. 102 (b) as being anticipated by Examples 19 and 20 of U.S. Patent 4,961,870 (Cook). This rejection is respectfully traversed with respect to all of Applicants' pending claims.

Example 19 of the Cook patent discloses azeotrope-like compositions of 60 weight percent 1,1,2-trichloro-1,2,2-trifluoroethane (CFC-113); 37 weight percent trans 1,2-dichloroethylene; 3 weight percent 2-methyl-2-propanol; 200 ppm 1,2-butylene oxide; and 200 ppm 4-methoxyphenol. Example 20 of the Cook patent differs from Example 19 only by substituting 3-pentanol for 2-methyl-2-propanol.

The express disclosure of the cited Cook patent and the disclosure of U.S. Patent 4,804,493, which is referred to in the Cook patent, states that the compositions of Examples 19 and 20 are azeotrope-like compositions. These compositions contain **CFC 113**, trans-1,2-dichloroethylene and minor amounts of stabilizers. See column 2, lines 59-60, and column 10, line 59 of the Cook patent. In contrast, Applicants' claims are directed to a composition consisting essentially of trans-1,2-dichloroethylene and minor amounts of stabilizers. The claimed compositions are not azeotropic or azeotrope-like compositions. Moreover, in view of the recitation of the transitional phrase "consisting

essentially of" Applicants' claims exclude the presence of such a major amount (i.e., 60 weight percent) of a chlorofluorohydrocarbon such as CFC-113. Accordingly, the claimed compositions differ markedly from the compositions described in Examples 19 and 20 of the Cook patent.

Applicants' claims employ the transitional phrase "consisting essentially", which excludes any ingredient that materially affects the basic and novel characteristics of the claimed invention. See section 2111.03 of the Manual of Patent Examining Procedure. Examples 19 and 20 of the Cook patent describe compositions that contain **60** weight percent of 1,1,2-trichloro-1,2,2-trifluoroethane (CFC-113). The presence of a chlorofluorohydrocarbon in Applicants' compositions would likely **materially affect** Applicants' claimed composition. Note, for example, that the compositions of Examples 19 and 20 of the Cook patent are **azeotrope-like compositions**, whereas Applicants' claimed compositions are **neither** azeotropic nor azeotrope-like compositions. Applicants' claimed compositions consist essentially of trans 1,2-dichloroethylene and minor amounts of a combination of stabilizer materials.

Accordingly, the Cook patent disclosure **does not anticipate** Applicants' claimed compositions under 35 U.S.C. 102 (b). Reconsideration of this rejection and allowance of all of Applicants pending claims are respectfully requested.

The Restriction Requirement

The Examiner has maintained the restriction requirement between Applicants' composition claims (claims 1-23) and process claims (claims 24-29). It is argued that material limitations are given greater weight than intended use limitations in composition claims, whereas the intended use, substrate, and process limitations are given greater weight in process claims than material limitations. Nevertheless, it should be noted that Applicants' process claims contain only a reference to the intended use of the compositions (vapor degreasing) claimed in the composition claims. Accordingly, the differences between the Applicants' process claims and their composition claims are not so substantial as to warrant separation of those claims into two patents.

Further, it is noted that the Cook patent relied upon in the rejection contains **both composition claims and method claims**. Accordingly, the U.S. Patent Office has

recognized that a restriction between composition and process claims in cases such as that presented in the instant application (and the Cook patent) is not required and should not be made. Reconsideration of the restriction requirement and rejoinder of claims 1-23 with claims 24-29 is respectfully requested.

Respectfully submitted

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